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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,823	10/07/2004	Burkhard Pollak	LUKP:123US	5822
24041	7590	04/19/2006	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			HANSEN, COLBY M	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/711,823		POLLAK ET AL.	
	Examiner		Art Unit	
	Colby Hansen		3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/27/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed 2/3/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amended drawing of figure 2 with respect to the “guide shoe” 38 constitutes new matter; additionally the amendment to the specification is deemed new matter as such structural limitation of the term “jib” can not be accurately discerned from the drawings.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bearing arrangement consisting of “two symmetric jibs”, as claimed in claims 6-7, and the “guide shoe parts at their ends resting against the gearshift rails”, as claimed in claim 8, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claim 1, applicant claims that the bearing arrangement operatively arranged to support and guide the gearshift rails. However, it is unknown how the "jibs" serve the purpose of "guiding" the rails as the rails appear to simply slide across the lower "jibs" with no reduction of the degrees of

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freedom outside the support aspect. Additionally, the upper “jibs” appear to serve neither of the “support” or “guide” aspects of the claim limitations.

Additionally, with regard to claim 8, it is unknown what the “guide shoe parts” are with respect to the rails, as they appear not to be shown (however they are given part number 38), and are insufficiently described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, it is unclear what the metes and bounds are of the term “disengaging shaped elements”. Additionally, it is unclear what the “single” selector shaft refers to, as it could be the spindle 9, selector switch, or the shaft the disengaging shaped elements are upon.

Furthermore, with regard to claims 2-9, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “jibs” in claims 2-9 is used by the claim to mean “cantilevered support”, while the accepted meaning is “a triangular sail stretching from the

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foretopmast head to the jib boom and in small craft to the bowsprit or the bow or the arm of a mechanical crane or the boom of a derrick.” The term is indefinite because the specification does not clearly redefine the term. Furthermore, its use appears to be repugnant to the common understanding of the term as its intended use is functionally inconsistent with the mechanical use of a jib in a boom of a derrick or the arm of a crane therefor rendering its use indefinite.

Furthermore, with regard to claims 6-7, it is unclear what the structure is of the “two symmetric jibs” is with respect to the invention, as it has not been shown or sufficiently described to facilitate a complete and accurate search. The recitation could refer to the two lower jibs or an upper jib and a lower jib.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Weston (US Pat. 5,816,101).

Weston (US Pat. 5,816,101) discloses a gearbox actuator 100 comprising: a single selector shaft 112-117 (each selector shaft constitutes a “single” selector shaft) driven by a drive and arranged in a housing upon which are arranged a shift finger and disengaging shaped elements (the direct mechanical interaction between 112-117, 140, lock-out plunger 150 and the

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shift rails 130, 140) that operate gearshift rails; and, a bearing arrangement 120 (figs. 4-6) operatively arranged to support and guide the gearshift rails wherein the bearing arrangement is formed by jibs that receive the gearshift rails between them (the left/right opening of support for 130 are interpreted as being the two lower jibs, and the left/right opening of support for 140 are interpreted as the two upper jibs (fig. 5)); wherein the housing comprises an attachment part operatively arranged to be attached to a gear housing of a gearbox where said jibs protrude through an opening or recess in the gear housing into the gearbox actuator housing (fig. 3); wherein the attachment part and the jibs have the shape of an injection molded part, as broadly recited the jibs are in a shape the could be made by injection molding; wherein there are provided two upper jibs and two lower jibs that are opposite each other with respect to the selector shaft; wherein two jibs are provided; wherein two jibs at a time are symmetrically opposite each other with respect to the selector shaft (interpreted that the entire length of the respective supports 130', 140' are jibs); wherein the jibs have guide shoe parts at their ends resting against the gearshift rails (incorporated into the jib such that the jibs substantially conform to the shape of the shafts, thereby providing support in multiple directions).

Furthermore, with regard to claims 4 and 9, applicant's claims that the parts are made by injection molding are product-by-process claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Therefor Weston must only by capable of being made by injection molding, which it is.

Response to Arguments

Applicant's arguments filed 2/3/2006 have been fully considered but they are not persuasive.

Applicant's amendment to the specification regarding the jib is considered new matter, as such specific structural limitations of the term can not be accurately discerned from the drawings. Additionally, the term "jib" and applicant's understanding of the term, is repugnant to the common understanding in definition, structure, and functionality.

Applicant's drawing amendment have been deemed new matter as no place in the original specification are two upper and two lower "jibs" disclosed with "guide shoes".

Regarding the 35 USC 112, 1st paragraph rejections, Examiner still feel that the "jibs" not enabled as the rails are inherently "guided" and "supported" by their transmission connections with the "jibs" serving only to create friction and wear. Additionally, as seen in figure 3, the "jibs" fail to even touch the middle rail. Regarding the "guide shoe", said elements still have not described or shown the drawings such that their specific relationship with the rails could be discerned.

Regarding the 35 USC 112, 2nd paragraph rejections, the term "disengaging shaped elements" is still indefinite. It would not be clear to one with ordinary skill in the art to know what a "disengaging shape" is. With regard to claim 6, it is unclear which of the four jibs are being claimed. "Symmetric" jibs could be a combination of any two of the four jibs, as broadly recited; with out knowing this the claims are indefinite.

With regard to the 35 USC 102(b) rejection, Examiner contend Weston discloses a "single" shaft as each of the shafts of Weston constitute a "single" shaft, as broadly recited.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the jibs being cantilevered bars) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regard to applicant's arguments that Weston does not disclose the rails "between them" (referring to the jibs), Examiner disagrees for the support may be integral and surround the rails, but it does have a right side and a left side, respectively, between which the rail resides therefor fulfilling the extreme broad recitation.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MEP. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

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Responses submitted by facsimile transmission should include a Certificate of Transmission (MEP. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MEP. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colby Hansen whose telephone number is (571) 272-7105. The examiner can normally be reached on Monday through Thursday and every other Friday from 7:30 PM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley, can be reached on (571) 272-6917. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Colby M. Hansen

Patent Examiner

 4/17/06



RICHARD RIDLEY
SUPERVISORY PATENT EXAMINER